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31083 7590 06/26/2007 THOMTE, MAZOUR & NIEBERGALL, L.L.C. 2120 S. 72ND STREET, SUITE 1111 OMAHA, NE 68124				
			EXAMINER KURTZ, BENJAMIN M	
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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 10/829,005
Filing Date: April 21, 2004
Appellant(s): MUNN, MYRON L.

Dennis L. Thomte
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed 3/12/07 appealing from the Office action mailed 3/9/07.

(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The statement of the status of claims contained in the brief is correct.

(4) Status of Amendments After Final

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

(6) Grounds of Rejection to be Reviewed on Appeal

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon

5 766 451

Sparling

June 16, 1998

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

1. Claims 4 and 7 are rejected under 35 U.S.C. 102(b) as being anticipated by Sparling US 5 766 451.

Regarding claim 4, Sparling teaches an oil filter adapter comprising: a disc-shaped adapter member (10) having an engine side and a filter side, said engine side having an annular o-ring (36) in a groove (38), the o-ring has the same diameter of a standard canister o-ring, the adapter member has an internally threaded central opening (20) formed therein which extends inwardly from said engine side thereof which is adapted to threadably receive an externally threaded filtered oil tube of the oil filter receptacle, said adapter member having an externally threaded, hollow nipple (40) extending from its said filter side at the center thereof which is in communication with the interior of said internally threaded central opening in the adapter member, the threads of the hollow nipple matches the threads of the oil outlet of the replacement oil filter canister (48), the adapter member having a plurality of spaced apart unfiltered oil

passageways (17) formed therein which extend therethrough from said engine side to said filter side thereof outwardly of said central opening of said adapter member, the filter side of the adapter member having an annular seat (26) formed thereon which is positioned outwardly of said hollow nipple and said unfiltered oil passageway thereof, the internally threaded filtered oil outlet of oil filter canister threadably receives said externally threaded hollow nipple whereby the canister o-ring may be drawn into sealing engagement with said annular seat of the adapter member (fig. 3).

Regarding claim 7, Sparling further teaches the annular seat on said filter side of the adapter member has a width sufficiently large enough to enable replacement oil filter canister o-rings of various diameters to be placed into sealing engagement therewith (fig. 3).

2. Claim 6 is rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Sparling '451.

Sparling teaches the threads of the internally threaded central opening of the adapter member are different than the threads on said hollow nipple (col. 7, lines 53-59) but is silent about the internally threaded opening threads are SAE threads and the hollow nipple threads are metric threads. Having different configurations of a filter and its connections would imply such a configuration as taught by Sparling (col. 7, lines 53-59) or in the alternative would be obvious to one of ordinary skill in the art at the time the invention was made because the use of metric and SAE type threads are commonplace in engine connections and oil filters.

3. Claim 8 is rejected under 35 U.S.C. 103(a) as being unpatentable over Sparling '451.

Sparling teaches the adapter member of claim 4 but does not teach a one-piece construction. It would have been obvious to one of ordinary skill in the art at the time the invention was made to make the adapter member and the hollow nipple a one-piece construction because "the use of a one-piece construction...would be merely a matter of obvious engineering choice" *In re Larson*, 144 USPQ 347,349 (1965).

(10) Response to Argument

The response to arguments detailed below follow in the same order as the arguments presented in the appeal brief.

(A) Claims 4 and 7 are not patentable over Sparling US 5 766 451 pursuant to 35 USC § 102(b).

The scope of the appellant's arguments is not commensurate with the scope of the claims. Claim 4 is directed to an oil filter adapter. The appellant's argument pertains to the size of the gasket or o-ring of the replacement filter cartridge and not to the structure of the filter adapter. The appellant relies on the following section of claim 4 in the arguments presented in the appeal brief:

4. (Appealed) **An oil filter adapter** for attachment to the externally threaded filtered oil tube extending outwardly from an oil filter receptacle of an automotive engine which normally threadably receives the internally threaded filtered oil

outlet at one end of a standard oil filter canister with the one end thereof having a canister O-ring or gasket provided thereon, the adapter enabling a replacement oil filter canister to be substituted for the standard oil filter canister with one end of the replacement oil filter canister having a canister O-ring or gasket provided thereon outwardly of an internally threaded filtered oil outlet, the standard and replacement oil filter canisters having substantially the same diameter with the replacement oil filter canister having a greater length than the standard oil filter canister to provide a greater filter capacity thereof, the replacement canister O-ring or gasket having a greater diameter than the standard canister O-ring or gasket, the oil filter adapter comprising:

...

(Emphasis and underlining added)

The section of claim 4 relied upon describes the intended use of the oil filter adapter and does not add any structural limitation to the claimed oil filter adapter. The adapter as taught by Sparling contains all of the structural limitations as recited in claims 4 and 7; the annular seat as taught by Sparling is capable of sealingly receiving o-rings or gaskets of varying sizes and diameters.

In response to appellant's argument that the Sparling adapter does not enable a replacement oil filter canister to be substituted for the standard oil filter as required by claims 4 and 7: see the figures of the filter adapter from the present application and that of Sparling copies below in figure 1. It is very clear that the Sparling adapter is capable

of accommodating a replacement oil filter in place of the original oil filter. Moreover, column 7, line 53-59 teaches that the thread can be configured to fit any filter.

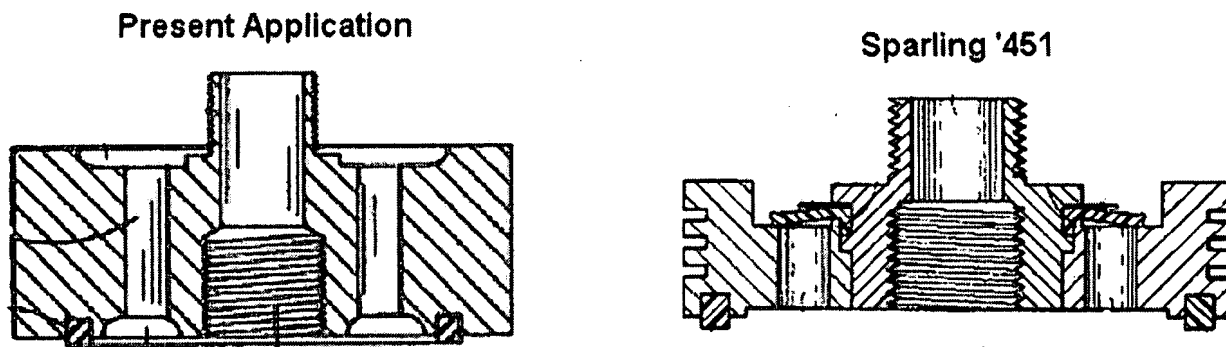


Figure 1: The filter adapter of the present application and the filter adapter of Sparling '451

(B) Claim 6 is anticipated by or, in the alternative, under 35 USC § 103(a) obvious over Sparling '451.

Sparling teaches the threading on the filter side of the adapter are threaded with conventional threads to fit a conventional spin-on type oil filter allowing any conventional industry standard spin-on oil filter to be used or the threading can be configured to fit any filter to match the desired filter (col. 7, lines 53-59). Both SAE and metric threads are common, conventional and standard threading in the automotive industry and therefore are anticipated by the claims. In the alternative, one of ordinary skill in the art would recognize the teaching of configuring the filter side of the threading to fit any desired filter to include SAE and metric threads as obvious because SAE and metric threads are common and conventional in the automotive industry.

(C) Claim 8 is unpatentable over Sparling '451 under 35 USC § 103(a).

Case law teaches it would have been obvious because "the use of a one-piece construction ... would be merely a matter of obvious engineering choice" *In re Larson*, 144 USPQ 347,349 (1965). One would be motivated to make a one-piece construction to reduce the number of parts, for example. Appellant argues that the two-part construction of Sparling could leak. However, there is no evidence to support this. Also, Appellant has not provided any secondary evidence to overcome the prima facie case of obviousness.

(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

Art Unit: 1723

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

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6/11/07

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6/12/07

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